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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/029,203      | 12/28/2001  | Katutada Shirai      | Q67944              | 5387             |

7590 08/27/2003

SUGHRUE MION, ZINN  
MACPEAK & SEAS, PLLC  
2100 Pennsylvania Avenue, NW  
Washington, DC 20037-3213

EXAMINER

NEGRON, ISMAEL

ART UNIT PAPER NUMBER

2875

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

10/029,203

Applicant(s)

SHIRAI, KATUTADA

Examiner

Ismael Negron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-12 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed on June 30 2003 has been entered. Claims have been amended, added or cancelled. Claims 1-12 are still pending in this application, with claim 1 being independent.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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2. Claims 1-6 and 8-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,315,438 (Shirai et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other.

Shirai et al. claims a vehicle headlamp having:

- **a lamp body**, patented claim 1, line 3;
- **a light source**, patented claim 1, line 4;
- **a reflector positioned to reflect light from the light source**, patented claim 1, line 4;
- **an aiming mechanism disposed between the lamp body and the reflector**, patented claim 1, line 5-10;
- **the aiming mechanism being operable to inclinably support and move the reflector relative to the lamp body**, patented claim 1, lines 7-10;
- **the aiming mechanism including a screw insertion hole provided to the lamp body**, patented claim 1, lines 8-10;
- **the screw insertion hole having a cylindrical portion**, patented claim 1, lines 11 and 12;
- **the aiming mechanism also including an aiming screw operable to move the reflector**, patented claim 1, lines 8-10;
- **the aiming screw having a supported section supported by the screw insertion hole**, patented claim 1, lines 13 and 14;

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- **the aiming screw also having a male screw portion forward of the supported portion, patented claim 1;**
- **the aiming screw also having a pivotal movement operating force transmitted portion rearward of the supported portion, patented claim 1, lines 8-10;**
- **a rearward end of the screw supporting portion includes an elastic locking portion operable to receive at least a portion of the aiming screw, patented claim 4, lines 5-10;**
- **a rearward end side of the supported portion being formed with an elastic skirt brought into contact with a peripheral edge portion on a forward end of the screw supporting hole to fixedly position the aiming screw, patented claim 3, lines 2-8;**
- **the elastic locking portion engaging the peripheral edge portion, patented claim 4;**
- **at least the supported portion being made of synthetic resin, patented claim 1, lines 13 and 14;**
- **the cylindrical portion being made of synthetic resin, patented claim 1;**
- **the lamp body having a vessel shaped, patented claim 1;**
- **the screw insertion hole being formed integrally with the lamp body, patented claim 4; and**

- **the outer peripheral face of the supported portion having elastic waterproof ribs formed integrally thereon, patented claim 2.**

Shirai et al. discloses all the limitations of the claims, except the elastic locking portion being located at the forward end of the supported portion, the pivotal movement operating force transmitted portion rearward of the supported portion including a crown gear; and a nut for receiving the male thread part of the aiming screw.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to change the location of the elastic locking portion from the rear of the screw supporting portion to the forward end of the supported portion, since it has been held that mere rearrangement or reversal parts essential working parts of a prior art structure involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Also, see *In re Einstein*, 8 USPQ 167.

Regarding the pivotal movement operating force transmitted portion including a crown gear, it would have been an obvious matter of design choice to use such crown gear, since the applicant has not disclosed that such particular element solves any problem or is for a particular reason. It appears that the claimed invention would perform equally well with the structure as claimed by Shirai et al.. In addition, crown gears are old and well known in the art for actuating operation of aiming mechanisms such as those featured by the claimed invention. See Section 6 of the instant application.

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Regarding the nut for receiving the male thread part of the claimed invention, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made that such nut is inherently included in the patented invention, as the reflector can not be adjusted with out it.

### ***Allowable Subject Matter***

3. Claims 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. The following is a statement of reasons for the indication of allowable subject matter:

Applicant teaches a vehicle headlamp including an aiming screw having an elastic locking portion being deformed elastically upon insertion into a screw-supporting hole, such locking portion engaging a peripheral edge of the supporting hole to fixedly position the aiming screw. The aiming screw also includes a male thread portion. The locking mechanism includes a plurality of tongue pieces provided at equal intervals in a peripheral direction of the supported portion of the aiming screw.

### ***Response to Arguments***

5. Applicant's arguments filed June 30, 2003 have been fully considered but they are not persuasive. However, a new description of the basis for rejection is presented in Section 2 of the instant Office Action.

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6. Regarding the Examiner's Non-Statutory Double Patenting rejection of claim 1 as unpatentable over claim 1 of U.S. Patent No. 6,315,438 (Shirai et al.), the applicant argues that modifying the structure of Shirai et al. to locate the rib in the front side of the supporting portion would change the operation of the aiming screw and as such does not meet the criteria set forth in *In re Japikse* (86 USPQ 73).

In response to applicant arguments, while it is true that *In re Japikse* do required that the operation of the original device be maintained after the propose modification, it is the Examiner's position that Shirai et al. do meet the cited requirements. Modifying the structure of Shirai et al. To include the elastic locking portions in the front end of the aiming screw supported portion would definitively change the way in which the complete structure is assembled since instead of inserting the aiming screw from the front side of the housing, it would need to be inserted from the rear side. However, the operation of the complete structure (emphasis added) would remain unchanged. Rotation of the aiming screw would caused movement of the reflector, the waterproof rib would act as a rotating water seal, and the elastic rib/rear peripheral portion combination would work with the locking portion/front peripheral portion to lock the screw supported portion in place.

Applicant's statements that the Examiner considers the "elastic water proofing rib" of Shirai et al. as equivalent to the claimed "elastic locking portion" are in error. While a double patenting rejection is based on the patented claims, an element-to-element correlation (applicant's Figure 7, Shirai et al. Figure 8) might clarify the way in which the instant claims and the patented claims are being interpreted by the Examiner.



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| Element                 | Reference Numbers   |                              |
|-------------------------|---------------------|------------------------------|
|                         | Instant Application | U.S. Patent No.<br>6,315,438 |
| Screw insertion hole    | 10a                 | 10a                          |
| Cylindrical portion     | 50                  | 50                           |
| Elastic locking portion | 38                  | 53                           |
| Peripheral edge         | 50a                 | 36a                          |
| Elastic waterproof rib  | 34a                 | 34a                          |
| Elastic rib             | 35b                 | 35a                          |
| rear extended portion   | 50b                 | peripheral portion of 10a    |
| Male screw portion      | 32                  | 32                           |

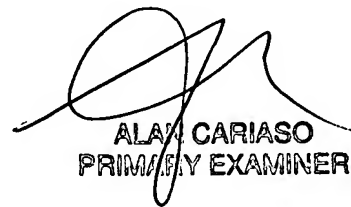
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***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negrón whose telephone number is (703) 308-6086. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (703) 305-4939. The facsimile machine number for the Art Group is (703) 308-7382.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.



ALAN CARIASO  
PRIMARY EXAMINER

Inr

August 22, 2003